

REMARKS

Upon entry of this First Response, claims 1-23 are pending in this application. Claims 1, 9, 17, 22, and 23 have been directly amended herein.

It is believed that the foregoing amendments add no new matter to the present application. Examination, consideration, and allowance of the application and all presently pending claims are respectfully requested.

Response to 35 U.S.C. § 101

Claims 9-16 presently stand rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. In particular, the Office Action states that "[a] claim for a computer program (a program listing/code) without the computer-readable medium needed to realize the computer program's functionality is non-statutory functional descriptive material." Further, the Office Action cites the Manual of Patent Examining Procedure (MPEP) §2106 IV. B.1. (a) as supporting said grounds for rejection.

Applicant traverses the non-statutory subject matter grounds of rejection of claims 9-16. Specifically, the cited MPEP section states

"a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory."

See MPEP §2106 IV. B. 1. (a).

In this regard, each of the claims 9-16 explicitly claims a "program embodied in a computer readable medium." Thus, Applicant submits that the claimed subject matter is not descriptive material per se, as stated in the Office Action. Instead, such claims recite patentable subject matter and thus define statutory inventions. Accordingly, Applicant respectfully requests that the 35 U.S.C. § 101 rejections be withdrawn.

Response to §102 Rejections

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior art reference disclose each element of the claim. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

Claim 1

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by *Kramer, et al.*
Claim 1 reads as follows:

1. A method for populating at least one region in a publication, comprising:
 - analyzing a work order comprising a template identifier associated with the publication and a plurality of content item identifiers identifying content items for populating a template;*
 - retrieving the template associated with the template identifier, the template defining the at least one region, the template further comprising an information identifier indicative of a type of content item for populating the at least one region;*
 - determining, based upon the type of content item, a number of content items for populating the at least one region in the publication;*
 - associating a priority with each of [[]]the number of content items to be populated into the at least one region of the publication in a computer system; and
 - populating the at least one region with at least one of the number of content items corresponding to the priority associated with each of the content items. (Emphasis added).

Applicant respectfully asserts that *Kramer et al.* fails to disclose at least the features of claim 1 highlighted hereinabove.

In particular, it appears that the system disclosed in *Kramer* comprises "two major independent processes: interpretation and illumination." See *Karmer*, column 5, lines 28-29. In this regard, the system disclosed "pars[es] and analyz[es] reports and other structured documents" in order to build a "personal database and models of the consumer." See *Kramer*, column 5, lines 30-35. The system then "annotat[es] or replac[es] sections" of the reports thereby "expand[ing] on the information in the original content and/or provides a more interesting presentation of the information." See *Kramer*, column 6, lines 22-46. In this regard, with respect to FIG. 14 of *Kramer*, it appears that the system receives the report, interprets the report to determine associated "illuminations," then constructs and displays the statement as shown in Fig. 14.

However, it does not appear that *Kramer* discloses “analyzing a work order comprising a template identifier associated with the publication and a plurality of content item identifiers identifying content items for populating a template,” “retrieving the template associated with the template identifier, the template defining the at least one region, the template further comprising an information identifier indicative of a type of content item for populating the at least one region,” and “determining, based upon the type of content item, a number of content items for populating the at least one region in the publication.”

For at least the aforescribed reasons, Applicant respectfully submits that *Kramer* is inadequate to anticipate each feature of amended claim 1, and the 35 U.S.C. §102 rejection of claim 1 should therefore, be withdrawn.

Claims 2-8

Claims 2-8 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly anticipated by *Kramer*. Applicants submit that the pending dependent claims 2-8 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-8 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 9

Claim 9 presently stands rejected under 35 U.S.C. 102(e) as being anticipated by *Kramer, et al.* Claim 9 reads as follows:

24. A program embodied in a computer readable medium for populating at least one region in a publication, comprising:
code for analyzing a work order comprising a template identifier associated with the publication and a plurality of content item identifiers identifying content items for populating a template;
code for retrieving the template associated with the template identifier, the template defining the at least one region, the template further comprising an information identifier indicative of a type of content item for populating the at least one region;
code for determining, based upon the type of content item, a number of content items for populating the at least one region in the publication;
code that associates a priority with each of a number of content items to be populated into the at least one region of the publication; and

code that populates the at least one region with the content items in an order corresponding to the priority associated with each of the content items. (Emphasis added)

For at least those reasons argued hereinabove with respect to claim 1, Applicant submits that *Kramer* fails to disclose at least the features of amended claim 9 highlighted hereinabove. Accordingly, Applicant requests that the 35 U.S.C. 102(e) rejection of claim 9 be withdrawn.

Claims 10-16

Claims 10-16 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly anticipated by *Kramer*. Applicants submit that the pending dependent claims 10-16 contain all features of their respective independent claim 9. Since claim 9 should be allowed, as argued hereinabove, pending dependent claims 10-16 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 17

Claim 17 presently stands rejected under 35 U.S.C. 102(e) as being anticipated by *Kramer, et al.* Claim 17 reads as follows:

17 A system for populating at least one region in a publication, comprising:

means for analyzing a work order comprising a template identifier associated with the publication and a plurality of content item identifiers identifying content items for populating a template;

means for retrieving the template associated with the template identifier, the template defining the at least one region, the template further comprising an information identifier indicative of a type of content item for populating the at least one region;

means for determining, based upon the type of content item, a number of content items for populating the at least one region in the publication;

means for associating a priority with each of a number of content items to be populated into the at least one region of the publication; and

means for populating the at least one region with the content items in an order corresponding to the priority associated with each of the content items. (Emphasis Added).

For at least those reasons argued hereinabove with respect to claim 1, Applicant submits that *Kramer* fails to disclose at least the features of amended claim 17 highlighted hereinabove. Accordingly, Applicant requests that the 35 U.S.C. 102(e) rejection of claim 17 be withdrawn.

Claims 18-21

Claims 18-21 presently stand rejected in the Office Action under 35 U.S.C. §102 as allegedly anticipated by *Kramer*. Applicants submit that the pending dependent claims 18-21 contain all features of their respective independent claim 17. Since claim 17 should be allowed, as argued hereinabove, pending dependent claims 18-21 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Claim 22

Claim 22 presently stands rejected under 35 U.S.C. 102(e) as being anticipated by *Kramer, et al.* Claim 22 reads as follows:

22. A method for populating at least one region in a publication, comprising:
identifying a number of content items with which to populate the at least one region of the publication in a computer system;
associating a priority with each of the content items based upon a consumer profile;
identifying a preference within a work order corresponding to the publication, the preference associated with select ones of the content items;
adjusting the priority associated with the select ones of the content items based upon the respective preferences;
populating the at least one region with the content items in an order corresponding to the priority associated with each of the content items; and
discarding select ones of the content items that do not fit within a remaining unpopulated portion of the at least one region. (Emphasis Added).

Applicant respectfully asserts that *Kramer* fails to disclose at least the features of claim 22 highlighted hereinabove.

In particular, the system disclosed in *Kramer* appears to receive illuminations that are "selected without their provider having any explicit access to the facts or model of the consumer" that may be "displayed initially in the...document." See *Kramer*, column 32, lines 45-65. Thereafter, based upon a "click[]" on the content item," the disclosed system

transmits an "explicit request" for "a more specific set of illuminations." See columns 32, lines 65 – column 33, lines 25.

However, it does not appear that Kramer discloses "associating a priority with each of the content items based upon a consumer profile," "identifying a preference within a work order corresponding to the publication associated with select ones of the content items," and adjusting the priority associated with the select ones of the content items based upon the respective preferences;

For at least the aforescribed reasons, Applicant respectfully submits that *Kramer* is inadequate to anticipate each feature of amended claim 22, and the 35 U.S.C. §102 rejection of claim 1 should, therefore, be withdrawn.

Claim 23

Claim 23 presently stands rejected under 35 U.S.C. 102(e) as being anticipated by *Kramer, et al.* Claim 23 reads as follows:

23. A system for populating at least one region in a publication, comprising:

means for identifying a number of content items with which to populate the at least one region of the publication in a computer system;

means for associating a priority with each of the content items based upon a consumer profile;

means for identifying a preference within a work order, the preference associated with select ones of the content items;

means for adjusting the priority associated with the select ones of the content items based upon the respective preferences;

means for populating the at least one region with the content items in an order corresponding to the priority associated with each of the content items; and

means for discarding select ones of the content items that do not fit within a remaining unpopulated portion of the at least one region.
(Emphasis Added).

For at least those reasons argued hereinabove with respect to claim 22, Applicant submits that *Kramer* fails to disclose at least the features of amended claim 23 highlighted hereinabove. Accordingly, Applicant requests that the 35 U.S.C. 102(e) rejection of claim 23 be withdrawn.

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CONCLUSION

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

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